

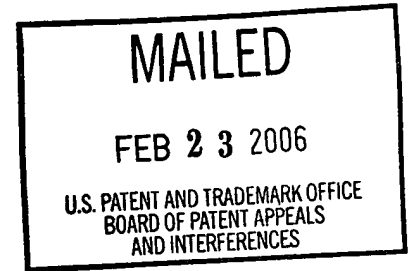
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte HIRONOBU SHINOHARA

Application No. 10/645,533



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on February 7, 2006. A cursory review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

On September 2, 2005, appellant filed an Appeal Brief under the rules set forth in 37 CFR § 41.37(c). 37 CFR § 41.37(c) states in-part:

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along

with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

. . . .

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

The Appeal Brief reveals that the following section is missing:

- (1) "Evidence Appendix," as set forth in 37 CFR § 41.37(c)(1)(ix).

A supplemental brief that is in compliance with 37 CFR § 41.37(c) is required. For more information on the Board's new rules see the web page entitled "More Information on the Rules of Practice Before the BPAI, Final Rule" at:  
<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

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Further review of the Image File Wrapper (IFW) reveals that the Answer, mailed October 31, 2005, is deemed non-complaint with the new rules set forth in 37 CFR § 41.39 effective September 13, 2004. The IFW application reveals that the following content is missing from the Examiner's Answer in the order and with the context stated in the Rules:

Section "(8) Evidence Relied Upon," fails to list the relevant references applied in the rejections on appeal.

Correction is required pertaining to the headings and content required in the Examiner's Answer.

Accordingly, it is

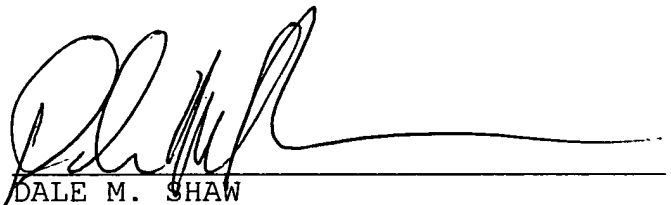
ORDERED that the application is returned to the examiner to:

- have the appellant submit a supplemental Appeal Brief in compliance with the new rules set forth in 37 CFR § 41.37(c);
- submit a revised Examiner's Answer in accordance with the new rules effective September 13, 2004; and

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- for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

A handwritten signature in dark ink, appearing to read 'D. M. Shaw', is written over a horizontal line.

DALE M. SHAW  
Program and Resource Administrator  
(571) 272-9797

DMS:hh

cc: OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314